

Application No. 10/607,519
Art Unit 1711
Reply to Office Action of September 28, 2004

REMARKS

Applicants respectfully request that the Examiner reconsider the present application in view of the foregoing claim amendments.

In the present reply, the specification has been amended to correct a typographical error occurring in Table 3. Specifically, in the column labeled "Comp. Ex. 7", "PA66" was amended to read "PA6T/66". Support for the amendment to Table 3 can be found in the specification at page 24, lines 17-18 and at page 26, lines 15-16 (stating the same resin used in Inventive Examples is used in Comparative Examples). No new matter has been added.

Also, in the present reply, claims 1, 3, 4 and 5 have been amended, and new claim 6 has been added. Claim 2 remains in its original form. Thus, claims 1-6 are pending in the present application.

No new matter has been added by way of the amendments and new claim, because each amendment and new claim is supported by the present specification and/or is editorial in nature. For example, the amendment to claim 1 has support in the present specification at page 15, lines 15-22. The amendment to claim 3 has support in the present specification at page 16, line 10 to page 17, line 7. The amendment to claim 4 is obviously editorial in nature. Support for new claim 6 can be found in the present specification at page 14, lines 19-24. Thus, no new matter has been added.

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Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the objection and all other rejections and allow the currently pending claims.

Claim Objections

Claim 5 is objected to under 37 C.F.R. § 1.75(c) as being in improper form (see paragraph 1, page 2 of the Office Action). The amendment to claim 5 made herein renders this rejection moot. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Issues Under 35 U.S.C. § 112, Second Paragraph

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness (see paragraph 2, page 2 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested based on the following.

Claim 1 has been amended herein to replace "the metallic soap component (B) comprises a metallic soap comprising an aliphatic carboxylic acid of 20 to 25 carbon atoms and a monovalent or divalent metal salt" with "the metallic soap component (B)

comprises a monovalent or divalent metal salt of an aliphatic carboxylic acid of 20 to 25 carbon atoms." Thus, Applicants respectfully submit that one of skill in the art, upon reading the claim and the present specification, readily understands what is being claimed.

Applicants submit that with the amendment to claim 3, the lubricant of a metal salt of aliphatic carboxylic acid of 26 to 32 carbon atoms as a filler is clearly distinguishable from the specific component (B) comprising a monovalent or divalent metal salt of an aliphatic carboxylic acid of 20 to 25 carbon atoms. In this regard, Applicants also respectfully refer the Examiner to page 16, line 10 to page 17, line 7 of the present specification, which describes the filler of claim 3. Thus, one of skill in the art understands that the filler as recited in claim 3 can be added separately from the claimed component (B) (*i.e.*, filler can be blended with the claimed polyamide composition in addition to the components (A) and (B)).

With regard to claim 4, one of skill in the art would understand that this claim relates to a different embodiment of the present invention.

Thus, Applicants respectfully submit that the disputed claims fully comply with the provisions of 35 U.S.C. § 112, second

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paragraph. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakai et al. '843 (U.S. Patent 5,183,843) (as stated in paragraphs 3-4 of the Office Action). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are respectfully requested.

Distinctions over Sakai '843 Disclosure

At page 3 of the Office Action, the Examiner states that Sakai '843 differs from the present invention in not "expressly exemplifying" the use of the specific metallic soap component (B) comprising a monovalent or divalent metal salt of an aliphatic carboxylic acid of 20 to 25 carbon atoms. In this regard, Applicants respectfully refer the Examiner to the claims as presented herein and respectfully submit that a *prima facie* case of obviousness has not been established. U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those

of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); see also *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). Here, not even the first requirement of disclosure of all claimed features has been satisfied. Thus, Applicants submit that this rejection has been overcome.

Applicants respectfully further submit that the other requirements for a *prima facie* case of obviousness have not been satisfied. The Office Action at page 3 states that, in essence, it would be obvious to employ the claimed metallic salt of an aliphatic acid of 20 to 25 carbon atoms. Applicants respectfully disagree and submit that the requisite motivation and reasonable expectation of success are lacking, as follows.

Sakai '843 uses carboxylic acids with longer carbon chains. In this regard, Applicants respectfully submit that Sakai '843 properly corresponds to the Comparative Examples in Applicant's specification. Specifically, Na-Mon (28 carbon atoms) and Ca-Mon (28 carbon atoms) are used in Comparative Examples 2-3,

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respectively, of the present specification (see page 28, Table 1), whereby these Comparative Examples correspond to Examples 1, 2, 6 and 7 of Sakai '843. As can be seen from Table 1 in the present specification, the flow length is as short as 75 mm and 70 mm for Comparative Examples 2-3, respectively.

In contrast, and also as shown in Table 1 of the present specification, when Li-Beh (22 carbon atoms) and Mg-Beh (22 carbon atoms) are used as the metallic soap component (B) (see Examples 1-4), the flow length is larger and attains unexpectedly better values of 81-88 mm.

Thus, as compared with the comparative compositions as in the Examples of Sakai '843, the presently claimed invention has achieved markedly and unexpectedly improved flow length while maintaining an excellent shot stability and minimal difference between the mold release power at the 20th shot and that at the 50th shot.

Moreover, the composition using Li-St (18 carbon atoms), which is Comparative Example 1 as shown in Table 1 of the present specification, has produced an improved flow length, but at the same time achieves inferior shot stability. In contrast, the inventive compositions have simultaneous, markedly improved flow length and excellent shot stability.

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In addition, as shown in Table 3, page 29 of the present specification, adding a glass fiber, flame retardant and flame retarding assistance as fillers to the present invention also gives unexpected results. The inventive compositions using Li-Beh (22 carbon atoms) and Mg-Beh (22 carbon atoms) (see Examples 8-10) have achieved improved flow length (73-76 mm) while maintaining flame retardance and HDT. However, in contrast to the present invention, using Na-Mon (28 carbon atoms), such as that in Comparative Example 7, gives the flow length that is as short as 65 mm.

Therefore, Applicants respectfully submit that the formulations of the claimed invention are patentable distinct from the disclosure of the cited Sakai '843 reference. In particular, one of ordinary skill in the art would not be motivated in modifying Sakai '843 in order to achieve the present invention, since using the instantly claimed metallic soap component (B) comprising the monovalent or divalent metal salt of an aliphatic carboxylic acid of 20 to 25 carbon atoms gives such unexpectedly different and improved results. Further, the Tables in Sakai '843 clearly show better molding properties over the comparative examples and states that its invention solves problems associated with the state of the art, as further emphasized in the first paragraph in Col. 6. Here, Sakai '843 discloses to the skilled

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artisan that its invention solves the problems in the art, wherein there is no motivation to deviate from such solutions.

Applicants also traverse the conclusion regarding the present invention being an "obvious species" of Sakai '843 because Sakai '843 has such a generic disclosure. Picking a species out of such a generic disclosure amounts to an "obvious to try" rationale, wherein such an "obvious to try" rationale is improper for an analysis of patentability under § 103(a). See *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (CAFC 1988) (In *In re Fine*, the CAFC reversed the BPAI by stating: "The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," but neither of them offered any support for or explanation of this conclusion.") (emphasis added); see also *In re Deuel*, 34 USPQ2d 1210, 1216 (CAFC 1995) (where the court states: "Obvious to try" has long been held not to constitute obviousness. A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out") (citing *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-1681 (CAFC 1988)).

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established, since the requirements

thereof have not been satisfied. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

Unexpected Results Rebutting Rejection

Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on the modification of Sakai '843 or any other reference or combinations thereof).

In the Office Action at page 3, the Examiner states that absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter. However, the above-mentioned comparison between the present invention and the Comparative Examples (whereby the Comparative Examples correspond to the Sakai '843 embodiments) clearly shows that the presently claimed polyamide resin composition has unexpectedly good balance among flow length, mold release power and shot stability. As also mentioned above, the inventive Examples in Applicants' specification have unexpectedly achieved markedly improved flow length while at the same time achieving excellent shot stability.

Because one of skill in the art would understand the results obtained by the present invention are unexpected, Applicants respectfully submit that Sakai '843 fails to disclose or suggest

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the unexpected results attained by the polyamide resin composition as defined in the amended claims. Therefore, Applicants respectfully submit that because the claimed invention has achieved unexpected results, such unexpected results rebut any asserted *prima facie* case of obviousness and overcomes the outstanding § 103(a) rejection. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

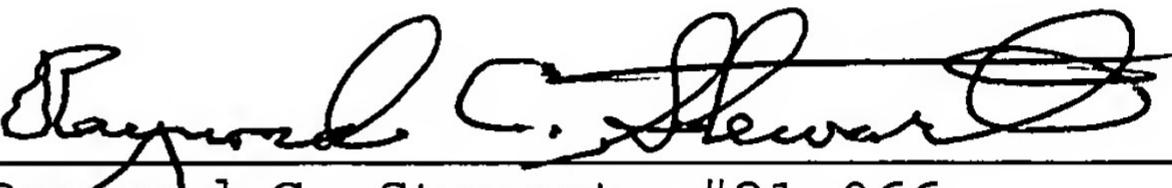
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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